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EXAMINER

TRAPANESI, WILLIAM C

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ERICK TSENG

Appeal 2016-006548
Application 12/917,747¹
Technology Center 2100

Before THU A. DANG, JOHN P. PINKERTON, and
JOHN D. HAMANN, *Administrative Patent Judges*.

PINKERTON, *Administrative Patent Judge*

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–3, 7, 9–16, 20, and 22–28, which are all of the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellant identifies Facebook, Inc. as the real party in interest. App. Br. 2.

STATEMENT OF THE CASE

Introduction

Appellant's disclosed and claimed invention is generally directed to "a communications or networking system that automatically establishes a connection to a target user in response to a user selecting an avatar representing the target user, and establishing a connection by a communication channel based on current context and one or more rules configured by the target user." Spec. ¶ 4.²

Claim 1 is representative and reproduced below (with the disputed limitations *emphasized*):

1. A method comprising:

by a client computing device, detecting activation of an avatar by a first user, wherein the avatar represents a second user and the avatar is displayed in a graphical user interface of a first application comprising a social-networking application on the client computing device;

by the client computing device, in response to detecting the activation, automatically sending a request to a server computing device to select a communication channel for connecting the first user to the second user, wherein selection of the communication channel is based on contact information of the second user and a current context of the second user;

by the client computing device, receiving from the server computing device communication-channel information for the communication channel selected for connected the first user to the second user; and

² Our Decision refers to the Final Office Action mailed Nov. 21, 2014 ("Final Act."); Appellant's Appeal Brief filed June 22, 2015 ("App. Br.") and Reply Brief filed June 20, 2016 ("Reply Br."); the Examiner's Answer mailed Apr. 20, 2016 ("Ans."); and the original Specification filed Nov. 2, 2010 ("Spec.").

by the client computing device, in response to receiving the communication-channel information from the server, automatically initiating without user input a connection between the first user of the social-networking application and the second user, the connection initiated by a second application comprising a communications application on the client computing device, the communications application associated with the communication channel selected by the server for connecting the first user to the second user.

App. Br. 21 (Claims App'x).

Rejections on Appeal

Claims 1–3, 7, 9–16, 20, and 22–26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Madhok (US 2010/0241634 A1; published Sept. 23, 2010), Cadiz et al. (US 2002/0186257 A1; published Dec. 12, 2002) (“Cadiz”), Sandell et al. (US 7,599,362 B2; issued Oct. 6, 2009) (“Sandell”), Xu (US 2008/0123587 A1; published May 29, 2008), and Horvitz (US 2002/0174199 A1; published Nov. 21, 2002).

Claims 27 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Madhok, Cadiz, Sandell, Xu, Horvitz, and Robinson et al. (US 2008/0222295 A1; published Sept. 11, 2008) (“Robinson”).

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellant’s arguments in the Briefs and are not persuaded the Examiner erred. Unless otherwise noted, we adopt as our own the findings and reasons set forth by the Examiner in the Office Action from which this appeal is taken (Final Act. 2–15) and in the Examiner’s Answer (Ans. 2–5), and we concur with the conclusions reached by the Examiner. For emphasis, we consider and highlight specific arguments as presented in the Briefs.

*Rejection of Claims 1–3, 7, 9–16, 20, and 22–26 under § 103(a)*³

Appellant contends the proposed combination of Madhok, Cadiz, Sandell, Xu, and Horvitz does not teach or suggest the disputed limitations of claim 1. App. Br. 14–17. In particular, Appellant argues there is no disclosure in Madhok of “by the client computing device . . . automatically initiating without user input a connection . . . by a second application comprising a communications application on the client computing device, the communications application associated with the communication channel selected by the server . . . ,’ as recited in Claim 1.” App. Br. 16; Reply Br. 2–3. Appellant argues Sandell requires the user to select the desired communication channel and does not teach or suggest ““automatically initiating without user input a connection . . . by a second application comprising a communications application . . . selected by the server,” as recited in Appellants’ Claim 1. App. Br. 16. Appellant also argues Horvitz indicates that the user of the device selects the communication channel and does not teach or suggest ““by the client computing device, in response to receiving the communication channel information, automatically initiating without user input a connection between the first user and the second user by a second application comprising a communications application on the client computing device, the communications application associated with the communication channel selected by the server for connecting the first user and the second user,’ as recited in Claim 1.” App. Br. 16–17; Reply Br. 3–4. Appellant

³ We decide the rejection of claims 1–3, 7, 9–16, 20, and 22–26, which are rejected under the first-stated ground of rejection, on the basis of representative claim 1. See 37 C.F.R. § 41.37(c)(1)(iv).

further argues that Xu does not teach the recited claim elements. Reply Br. 4.

Appellant also argues the Examiner relies on three distinct references with respect to the disputed limitations, and such a piecemeal rejection fails to give credence to the combination of features recited in claim 1 and appears to constitute impermissible hindsight. App. Br. 18–19. Appellant further argues the combination of references is improper because (1) the Examiner has not provided a motivation to combine the network-based systems of Madhok and Xu with the client-based system of Sandell, (2) the Examiner has not shown a suggestion or motivation in the references or the knowledge in the art to combine the references, or the desirability of the combination, and (3) incorporating Sandell’s client-based system would change the principle of operation of Madhok and Xu. Reply Br. 5–6.

We do not find Appellant’s arguments persuasive of Examiner error. First, we are not persuaded by Appellant’s arguments attacking Madhok, Horvitz, and Xu individually because they fail to address the Examiner’s specific finding, which is based on the combined teachings of Madhok, Horvitz, and Xu.⁴ See Ans. 2–4. See *In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (“Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.”). The relevant inquiry is whether the claimed subject matter would have been obvious to those of ordinary

⁴ Although the Examiner also relied on Sandell in the Final Office Action (Final Act. 5–6), in the Answer the Examiner finds “Madhok in view of Horvitz and Xu teaches all aspects of the limitation argued by applicant.” Ans. 4.

skill in the art in light of the combined teachings of the references. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Here, the Examiner finds Madhok teaches automatically initiating a connection between the first user and second user by the communication channel selected for connecting the first user to the second user. Ans. 2. In that regard, the Examiner finds Madhok teaches the communication can be dynamically initiated once the appropriate channel is determined. *Id.* (citing Madhok Fig. 9, steps 904, 906, 908; ¶ 84). The Examiner notes “Madhok fails to teach that the server selects the communication channel.” Ans. 3. However, the Examiner finds Horvitz teaches “automatically initiating without user input” a connection between the client device and the second user based upon “the communication channel selected by the server” because Horvitz teaches automatically connecting users based upon a server determined communication channel without further input from the user. *Id.* (citing Horvitz ¶ 99). The Examiner also notes that Madhok in view of Horvitz fails to teach using a different application to initiate a connection between the users. *Id.* However, the Examiner finds “Xu teaches that the application of each communication channel is a unique application.” *Id.* (citing Xu ¶ 31). For the reasons provided by the Examiner, we find the preponderance of the evidence establishes that the combined teachings of Madhok, Horvitz, and Xu teach or suggest the disputed limitations of claim 1.

Second, we are not persuaded the Examiner’s rejection of claim 1 was improper because, as Appellant argues, a person of ordinary skill in the art would not be motivated to make the proposed combination without the benefit of impermissible hindsight. App. Br. 18–19; Reply Br. 5–6.

Appellant’s argument that the Examiner has not shown a suggestion or motivation in the references or the knowledge in the art to combine the references, or the desirability of the combination, is not persuasive because the Supreme Court has rejected the rigid requirement of demonstrating a teaching, suggestion, or motivation in the references to show obviousness. *See KSR Int’l Co., v. Teleflex Co.*, 550 U.S. 398, 419 (2007). As our reviewing court held:

KSR directs that an explicit teaching, suggestion, or motivation in the references is not necessary to support a conclusion of obviousness. 550 U.S. at 415–16. The Supreme Court has instructed that “a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions,” *id.* at 417, and apply “an expansive and flexible approach” to obviousness, *id.* at 415.

In re Ethicon, Inc., 844 F.3d 1344, 1350 (Fed. Cir. 2017).

Regarding the rationale for combining the references, the Examiner finds Madhok, Horvitz, and Xu, as well as Sandell, all relate to selected communication channels in electronic devices and “[e]ach reference is combined to provide a technique taught to improve the method of selecting communication channels as described in the patent document.” Ans. 4. Accordingly, we find the rejection is supported by “some articulated reasoning with some rational underpinning” to combine known elements in the manner required by the claim. *See KSR*, 550 U.S. at 418. We also find the combination of the teachings of Madhok, Horvitz, and Xu is merely a combination of known elements that would yield no more than predictable results. *See KSR*, 550 U.S. at 416 (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

Regarding Appellant's argument that the Examiner's rejection is based on impermissible hindsight, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. However, so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper. *See In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971). Appellant has not demonstrated the Examiner's proffered combination of references would have been "uniquely challenging or difficult for one of ordinary skill in the art." *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418). Although Appellant argues the client-based system of Sandell would change the principle of operation of Madhok and Xu (*see* Reply Br. 5–6), this argument is not persuasive because the Examiner does not rely on Sandell in the Answer. *See* Ans. 3–4. In addition, Appellant has also not provided objective evidence of secondary considerations, which our reviewing court guides "operates as a beneficial check on hindsight." *Cheese Sys., Inc. v. Tetra Pak Cheese and Powder Sys.*, 725 F.3d 1341, 1352 (Fed. Cir. 2013). Furthermore, even though the Examiner relies on the combined teachings of three references to teach or suggest the disputed limitations of claim 1, we agree with the Examiner that "reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention." Ans. 5 (citing *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991)). Thus, for these reasons, and because, as discussed *supra*, the rejection is based on the references and what they would have taught or suggested to a

person of ordinary skill in the art, we conclude the Examiner's rejection is not based on impermissible hindsight.

Accordingly, for the aforementioned reasons, and based upon a preponderance of the evidence, we are not persuaded the Examiner erred in (1) finding the combination of Madhok, Horvitz, and Xu teaches or suggests the disputed limitations of claim 1 and (2) concluding that the combination of Madhok, Horvitz, Xu, and Cadiz renders the subject matter of claim 1 obvious under 35 U.S.C. § 103(a). Accordingly, we sustain the Examiner's rejection of claim 1, as well as independent claim 14, and dependent claims 2, 3, 7, 9–13, 15, 16, 20, 22, and 23–26.

Rejection of Claims 27 and 28 under § 103(a)

Appellant argues claims 27 and 28 are allowable because they depend from claim 1, which Appellant argues has been shown to be allowable. App. Br. 19. We are not persuaded by this argument, because for the reasons stated *supra*, we conclude claim 1 is not allowable. Thus, we sustain the Examiner's rejection of claims 27 and 28.

DECISION

We affirm the Examiner's rejections of claims 1–3, 7, 9–16, 20, and 22–28 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv). *See* 37 C.F.R. § 41.50(f).

AFFIRMED